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09/325,536 06/04/99 BOYLE K 47004.000040

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EXAMINER

THOMPSON JR, F

ART UNIT

PAPER NUMBER

2765

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/325,536

Applicant(s)
BOYLE et al.

Examiner
Forest Thompson Jr.

Group Art Unit
2765



☒ Responsive to communication(s) filed on Jun 4, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Claims 1-25 have been examined.

Drawings

2. The drawings received on 04 June 1999 are objected to by the Draftsperson (see form PTO 948).

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

3. Claim 25 is objected to because of the following informalities: The claim states "said club merchant or service provider" on pg. 24 in line 18. Claim 25 is dependent from independent claim 21 which states "a plurality of clubs, merchants or service-providers" on pg. 24 in lines 2-3, and dependent claim 23 which states "said plurality of clubs, merchants or service-providers" on pg. 24 in lines 14-15. Proper antecedent basis for the term in claim 25 is not provided nor identified by applicant. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claim 17 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claims 17 and 21, while consisting of several steps to perform functions, the claims recite the limitation "A method". The claim is not in the technological arts. Characterization of objects, determination of relations and entering data into a database do not require the technological arts, necessarily. Examiner notes that this rejection can be overcome by modifying the claims to include the technological arts. The specification provides support for the computer (technological) art, as stated on fig. 1 [100] and on pg. 8 at lines 16-21. The preamble should be changed to read "A computer-implemented method" to be patentable in the technological arts.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by **Fernandez-Holmann** (U.S. Patent No. 5,787,404).

As per claim 1, **Fernandez-Holmann** discloses:

- a credit card capable of charging point of service transactions (col. 2 lines 24-44); and

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- said credit card having encoded information thereon (col. 2 lines 24-44);

As per claim 2, **Fernandez-Holmann** discloses said encoded information is of an account number that is correlated by a credit card processing system to said plurality (col. 2 lines 24-44).

As per claim 3, **Fernandez-Holmann** disclose said cardholder's account is automatically updated to reflect said automated charges by said credit card processing system (col. 2 lines 24-44; col. 4 lines 9-34).

8. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by **Reeder** (U.S. Patent No. 6,014,636).

As per claim 13, **Reeder** discloses:

- a server for receiving applications, processing point of sale transactions and processing auto-charges to clubs, merchants or service providers (col. 2 lines 5-18).
- a plurality of user system (col. 2 lines 5-18); and
- a network interfacing said server and said plurality of user systems (col. 2 lines 5-18).

9. Claims 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kolling et al.** (U.S. Patent No. 5,920,847).

As per claim 21, **Kolling et al.** disclose:

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- periodically searching the database to identify a plurality of cardholders who are to be charged a fee or due (col. 11 lines 5-33);
 - generating a batch of transaction requests based on said step of searching (col. 36 lines 31-67; col. 37 lines 1-16);
 - submitting said batch to a transaction processor (col. 36 lines 31-67; col. 37 lines 1-16);
- and
- updating the accounts of said plurality of cardholders based on results reported by said transaction processor (col. 37 lines 27-30).

As per claim 22, **Kolling et al.** disclose automatically transferring funds to a club. merchant or service provider based on said results (col. 36 lines 31-67; col. 37 lines 1-30).

Claim 23 is written as a method and contains the same limitations as claim 22; therefore, the same rejection is applied.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fernandez-Holmann** (U.S. Patent No. 5,787,404).

As per claim 4, **Fernandez-Holmann** does not disclose encoded information thereon identifies one or more said plurality for use as an admission pass. However, Official Notice is taken that use of a credit card or other card as an admission pass was old and well known at the time the invention was made. One example is the use of an ATM card at a bank to open the door to access the area where an ATM is located. It would have been obvious to one skilled in the art to combine **Fernandez-Holmann** and old and well known art to disclose encoded information thereon identifies one or more said plurality for use as an admission pass, because this is a desirable security/access control feature for businesses and merchants.

12. Claims 5-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fernandez-Holmann** (U.S. Patent No. 5,787,404), and further in view of **Reeder** (U.S. Patent No. 6,014,636), and **Kolling et al.** (U.S. Patent No. 5,920,847).

As per claim 5, **Fernandez-Holmann** discloses:

- a server adapted to interface with user systems for receiving applications and batch processing auto-charge transactions; (col. 2 lines 27-38), through establishing a credit based account with a credit card issuer for the benefit of a credit card holder, providing an investment account with a financial institution for the benefit of the credit card holder, funding the

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investment account by the credit card issuer with a predetermined amount of money on a periodic basis, and charging an amount of money so funded against the credit based account of the credit card holder;

- a monetary processor system for processing point of sale transactions submitted over an interchange (col. 3 lines 19-21), by automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer; and
- the credit card holder may be billed by the credit card issuer for the amount of money funded to the investment account (col. 2 lines 45-47), by automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer.

Fernandez-Holmann does not specifically disclose a database containing a plurality of cardholders. **Fernandez-Holmann** does disclose through establishing a credit based account with a credit card issuer for the benefit of a credit card holder, and providing an investment account with a financial institution for the benefit of the credit card holder (col. 2 lines 27-38). These are actions associated with and necessary for creating and using a database.

Additionally, **Reeder** discloses a method for providing point-of-sale (POS) payment using interactive television (ITV) or the world wide web (WWW) by directly debiting a customer's bank account through electronic transfer of funds or by billing a customer's credit card account (Abstract).

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Neither **Fernandez-Holmann** nor **Reeder** specifically disclose a dues processor system for processing batch files of auto-charges. **Fernandez-Holmann** does disclose automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer (col. 3 lines 19-21).

Additionally, **Kolling et al.** disclose batch processing auto-charge transactions (col. 11 lines 5-33; col. 37 lines 9-17). Therefore, it would have been obvious to one skilled in the art to combine **Fernandez-Holmann**, **Reeder**, **Kolling et al.**, and old and well known art to disclose a server adapted to interface with user systems for receiving applications and batch processing auto-charge transactions; a monetary processor system for processing point of sale transactions submitted over an interchange; a dues processor system for processing batch files of auto-charges; and a database containing a plurality of cardholders, because this provides obvious benefits in the scope of the invention.

As per claim 6, **Fernandez-Holmann** discloses a report processor system for generating reports of account activity (col. 3 lines 11-21).

As per claim 7, **Fernandez-Holmann** discloses a transaction processor for accessing said database to determine if a transaction request is to be authorized (col. 5 lines 3-35).

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As per claims 8-12, **Fernandez-Holmann** does not disclose said database further contains information identifying a partner that is associated with a plurality of clubs, merchants, or service providers; said partner is a branch of the military, said partner is a university or college; said database contains information identifying one or more installations or bases of said partner; said database is a fully relational database allowing a cardholder to be transferred from one installation or base to another installation or base. Official Notice is taken that it was old and well known in the art at the time the invention was made that organizations may be associated with a plurality of clubs, merchants, or service providers for business or other purposes. One example of this are the gas stations located on military installations. Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that users of credit accounts or other types of accounts may relocate from time to time and still be able to use the credit instruments previously used, while providing update information as to the user's status and location/address. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Fernandez-Holmann, Kolling et al., Reeder**, and old and well known art to disclose said database further contains information identifying a partner that is associated with a plurality of clubs, merchants, or service providers, said partner is a branch of the military, said partner is a university or college, said database contains information identifying one or more installations or bases of said partner, nor said database is a fully relational database allowing a cardholder to be transferred from one installation or base to another installation or base, because this provides utility to the invention.

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Claim 17 is written as a method and contains the same limitations as claim 5; therefore, the same rejection is applied.

As per claim 18, **Fernandez-Holmann** discloses said step of entering data includes entry of information describing at least one of the frequency and date of the funds to be issued (col. 2 lines 23-44).

As per claim 19, **Fernandez-Holmann** discloses said step of entering data includes entry of information describing the amount of funds to be issued (col. 2 lines 23-44).

As per claim 20, **Fernandez-Holmann** discloses the step of processing a plurality of transaction requests based on said data (col. 4 lines 9-34).

13. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Reeder** (U.S. Patent No. 6,014,636).

As per claim 14 and 15, **Reeder** does not disclose at least one of said user systems is located at a military base, nor at least one of said user systems is located at a university or college. However, the location of the user system is not a necessary parameter in the use of the invention (outside the art), nor does it necessarily enhance or restrict the use of the invention since the invention may be used practically anywhere a computer may be used.

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14. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Reeder** (U.S. Patent No. 6,014,636), and further in view of **Fernandez-Holmann** (U.S. Patent No. 5,787,404).

As per claim 16, **Reeder** does not disclose a database of cardholders including information of charges to be automatically posted to cardholder accounts and credited to a club, merchant or service provider. However, **Fernandez-Holmann** discloses the system and methods of the preferred embodiment of the present invention described and claimed may be carried out by any of various computer based systems known in the prior art and programmed according the methodologies described herein in order to carry out the desired functions (col. 7 lines 31-36). and the credit card issuer automatically makes the required periodic payments to the investment account and bills the consumer accordingly along with the purchase charges normally incurred by the consumer (col. 3 lines 17-21). Also, Official Notice is taken that databases are old and well known in the art and are common to banks and credit card companies. Therefore, it would have been obvious to one skilled in the art to combine **Reeder**, **Fernandez-Holmann** and old and well known art to disclose a database of cardholders including information of charges to be automatically posted to cardholder accounts and credited to a club, merchant or service provider, because a database is common to most computer applications that must repetitively process large amounts of data, as in monthly bill and payment processing for credit cards.

15. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kolling et al.** (U.S. Patent No. 5,920,847).

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As per claim 24 and 25, **Kolling** does not disclose said club, merchant or service provider is located on a military base or installation. **Kolling** does disclose it is possible that service providers will provide services to a consumer regardless of the location of the consumer's account and that banks will accept payment authorization requests from any service providers (col. 32 lines 17-29). Additionally, the location of said club, merchant or service provider is not a necessary parameter in the use of the invention (outside the art), nor does it necessarily enhance or restrict the use of the invention.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes:

- **Pare, Jr. et al.** (U.S. Patent No. 5,805,719) disclose a tokenless identification system and method for authorization of transactions and transmissions.
- **Hilt et al.** (U.S. Patent No. 5,465,206) disclose a bill pay system wherein participating consumers pay bills to participating billers through a payment network operating according to preset rules.
- **Deo et al.** (U.S. Patent No. 5,721,781) disclose an authentication system which includes a portable information device (e.g., a smartcard) that is configured to store and process multiple different applications.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson whose telephone number is (703) 306-5449. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes can be submitted to (703)308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

August 23, 2000 /FOT



ERIC W. STAMBER
PRIMARY EXAMINER